

# ARNOLD & PORTER LLP

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February 20, 2004

**VIA HAND DELIVERY**

Mail Stop PGPUB-ABD  
Commissioner for Patents  
Crystal Park 3, Room 905  
Arlington, VA 22202-3729

Re: U.S. Application No. 09/849,529  
Filed: May 7, 2001  
Title: Nucleic Acid Molecules and Other Molecules Associated  
with Plants  
Applicants: Karen L. FINCHER *et al.*  
Atty. Docket: 16517.247

**RECEIVED  
USPTO-PG PUBS**

**FEB 20 2004**

Sir:

02/23/2004 KKING1 00000004 502387 09849529  
01 FC:1460 130.00 DA

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office (PTO):

1. a Petition for Express Abandonment Under 37 C.F.R. § 1.138(c) In Order to Avoid Publication; and
2. a return postcard.

Please stamp the attached postcard with the filing date of these documents and return it to our courier.

Applicants request that the following fee be charged to Deposit Account No. 50-2387 referencing docket number 16517.247:

\$ 130.00 petition fee

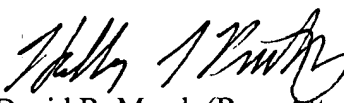
In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any fees, other than the above fee (\$130), are due in conjunction with this filing. However, if any additional fees under 37 C.F.R. §§ 1.16 or 1.17 are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter Deposit Account No. 50-2387 referencing matter number 16517.247. A duplicate copy of this letter is enclosed.

**OK FOR ABANDONMENT**

Respectfully submitted,

**FEB 23 2004**

**PG PUB DIVISION  
INITIALS SD**

  
David R. Marsh (Reg. Attorney No. 41,408)  
Holly Logue Prutz (Reg. Attorney No. 47,755)

Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Karen L. FINCHER *et al.*

Appln. No.: 09/849,529

Filed: May 7, 2001

For: Nucleic Acid Molecules and Other  
Molecules Associated with Plants

Art Unit: 1631

Examiner: Michael L. Borin

Confirmation No.: 8354

Atty. Docket: 16517.247

**Petition for Express Abandonment Under  
37 C.F.R. § 1.138(c) In Order to Avoid Publication**

Mail Stop PGPUB-ABD  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for express abandonment of U.S. Application Serial No. 09/849,529 under 37 C.F.R. § 1.138(c) as of the filing date granted to child Application Serial No. 10/767,795, filed January 29, 2004, naming David K. Kovalic, Yihua Zhou, and Yongwei Cao as inventors and having Attorney Docket No. 38-21(53534)B (the "Child Application"), for purposes of avoiding publication of the above-captioned U.S. application. Authorization to charge the official fees for this Petition is given in the accompanying transmittal letter. A duplicate copy of this Petition is enclosed.

On May 7, 2001, the above-captioned U.S. application was filed with a Request for Non-Publication, which contained a certification under 35 U.S.C. § 122(b)(2)(B)(i), including a statement that the invention "has not and will not be the subject of an application filed in another

country, or under a multilateral agreement, that requires publication at eighteen months after filing.” (Request attached hereto as Exhibit A). Thereafter it was discovered that one or more foreign applications, which may be related to the invention disclosed in the above-captioned U.S. application, were subsequently filed in another country or under a multilateral agreement that requires publication at eighteen months after filing. One such application was filed on December 17, 2001 (the “Foreign Application”).<sup>1</sup>

Applicants hereby petition for express abandonment of U.S. Application Serial No. 09/849,529 under 37 C.F.R. § 1.138(c) as of the filing date granted to the Child Application, for purposes of avoiding publication of the above-captioned U.S. application.<sup>2</sup>

The above-captioned U.S. application contains multiple sequences, only some of which may meet the criteria such that those sequences may be considered to be the “invention disclosed” within the meaning of 35 U.S.C. § 122. However, in lieu of submitting a redacted copy of the above-captioned U.S. application, provided for under 35 U.S.C. § 122 (b)(2)(B)(v), Applicants have elected to pursue the present course of action of refiling the less extensive Child Application, which contains only those sequences which may be disclosed in the Foreign Application without a request for non-publication.

Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below. The undersigned is an attorney of record, or an attorney acting in a representative capacity for Applicants by virtue of being named in the transmittal papers accompanying the above-referenced child application, and therefore has

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<sup>1</sup> Where more than one application was filed in another country or under a multilateral agreement, only the date for the earliest-filed foreign application is recited herein.

<sup>2</sup> In the papers filed on December 3, 2003, Applicants explicitly notified the Office of the filing of the Foreign Application on December 17, 2001, pursuant to 35 U.S.C. § 122 (b)(2)(B)(iii), rescinded the non-publication request, and petitioned for revival of the U.S. Application.

authority to petition for abandonment of the above-captioned U.S. application in favor of the above-referenced child application pursuant to 37 C.F.R. § 1.138(b), 1.33(b), and 1.34(a).

Respectfully submitted,

*Lawrence M. Lavin, Jr.*

Lawrence M. Lavin, Jr. (Reg. No. 30,768)  
by Holly Logue Prutz (Reg. No. 47,755)

*by Holly Logue Prutz*

Date: February 20, 2004

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>REQUEST AND CERTIFICATION UNDER 35 U.S.C. 122(b)(2)(B)(i)</b>	First Named Inventor		FINCHER, Karen L.
	Title	Nucleic Acid Molecules and Other Molecules Associated with Plants	
	Atty Docket Number		16517.247 [38-21(51893)B]

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b).

May 7, 01  
Date

David R. Marsh  
Signature

David R. Marsh (Reg. No.41,408)

Typed or printed name

This request must be signed in compliance with 37 CFR 1.33(b) and submitted with the application **upon filing**.

Applicant may rescind this nonpublication request at any time. If applicant rescinds a request that an application not be published under 35 U.S.C. 122(b), the application will be scheduled for publication at eighteen months from the earliest claimed filing date for which a benefit is claimed.

If applicant subsequently files an application directed to the invention disclosed in the attached application in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant **must** notify the United States Patent and Trademark Office of such filing within forty-five (45) days after the date of the filing of such foreign or international application. **Failure to do so will result in abandonment of this application (35 U.S.C. 122(b)(2)(B)(iii)).**

Burden Hour Statement: This collection of information is required by 37 CFR 1.213(a). The information is used by the public to request that an application not be published under 35 U.S.C. 122(b) (and the PTO to process that request). Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 6 minutes to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/849,529	05/07/2001	Karen L. Fincher	16517.247 [38-21 (51893)B]

CONFIRMATION NO.  
8354

ARNOLD & PORTER LLP  
ATTN: IP DOCKETING DEPT.  
555 TWELFTH STREET, N.W.  
WASHINGTON DC 20004-1206

**Decision Granting Petition under 37 CFR 1.138(c)**  
*The declaration of express abandonment is recognized*

This is in response to the petition under 37 CFR 1.138(c) that was filed on February 20, 2004, express abandonment to avoid publication of the above-identified application.

The petition is granted.

The express abandonment is recognized and the application has been withdrawn from publication.

A notice of abandonment will be mailed in due course.

Telephone inquiries should be directed to the Office of Patent Publication, the Pre-Grant Publication Division, at 703-605-4284.

Barbara J. Debnam  
Pre-Grant Publication Division  
Office of Patent Publication